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*Amendment After Final*  
*Attorney Docket No. M113.2N-10592-US02*

**Remarks**

This Amendment is in response to the Office Action dated **January 25, 2006**. In the Office Action, claims 18-33 were rejected under 35 USC 103 as being unpatentable over Diener (US 4,823,445) in view of Kalisz (6,315,152) and claims 18-33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of MacMurdo (US 6,659,313).

Applicant submits this Amendment which merely adopts the Examiner's suggestions, presents claims in better form for consideration on appeal, removes issues from appeal, or only requires a cursory review by the Examiner in compliance with 37 C.F.R. §1.116. Applicant presents claims herein and traverses the Examiner's rejection in so far as it may be applied against the claims as presented herein.

The paragraphs below correspond to those of the Office Action.

**35 USC § 103**

In the Office Action, claims 18-33 were rejected under 35 USC § 103 as being unpatentable over Diener (US 4,823,445) in view of Kalisz (6,315,152). To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations (MPEP 2142).

Independent claims 18 and 28 recite "said applicator comprising a tube, said tube being formed of material constructed and arranged to be magnetically attracted to the container wherein said tube engages said outside surface of the container for releasable affixation to said outside surface." Independent claim 29 recites "An applicator comprising a tube, said tube being formed of material constructed and arranged to be magnetically attracted to a container having an

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outside surface wherein said tube is releasably affixed to said outside surface.”

The Office Action states that “Diener et al discloses a container (C) having an outside surface and an interior and a **storage clip for holding an extending tube** directly onto an aerosol can” (emphasis added). Applicant notes that the storage clip (10) and the extending tube (T) are two different components. Diener does not teach or suggest a “said **tube** being formed of material constructed and arranged to be magnetically attracted to the container,” as recited by instant independent claims 18 and 28, or a “**tube** being formed of material constructed and arranged to be magnetically attracted to a container having an outside surface,” as recited in instant independent claim 29. In fact, Diener is silent as to what materials can be used to form the tube, instead the patent focuses on the inventive mechanical storage clip. The mechanical storage clip non-magnetically engages the tube to the exterior of the can. The Office Action acknowledges this by stating that “Diener does not disclose the tube being magnetically attracted to the outside surface of the container.”

The Office Action states that “Kalisz discloses a **tube storage device** that is magnetically attached to the container” (emphasis added). The tube storage device 30 (sleeve) of Kalisz is one embodiment used “for storing an extension tube with a spray can” (3:32). As with Deiner, the tube storage device 30 (sleeve) is not the extension tube 40, they are two different things. The tube storage device (sleeve), referred to in Kalisz as sleeve 30, is “made of magnetic material and engaged can 10 by magnetically adhering to can 10” (6:48-50). However, the extension tube taught or suggested in Kalisz is “a single, plastic, hollow extension tube” or a “red, polypropylene WD-40® extension tube” (1:40-41, 1:49 and 4:10). Plastic and polypropylene, by themselves, are not materials which are magnetically attracted to other materials. Kalisz teaches the magnetic engagement of the sleeve 30 to the can. Kalisz also teaches the mechanical

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teaches the mechanical engagement between the tube and the sleeve 30. Therefore, Kalisz does not teach or suggest a “said **tube** being formed of material constructed and arranged to be magnetically attracted to the container,” as recited by instant independent claims 18 and 28, or a “**tube** being formed of material constructed and arranged to be magnetically attracted to a container having an outside surface,” as recited in instant independent claim 29.

The Office Action asserts that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the attachment means of Diener with the magnetic attachment means as taught by Kalisz in order to more conveniently store the tube when not in use.” The Office Action concludes that “[t]his substitution requires that the tube be made of a magnetic material.” Applicant respectfully disagrees with this assertion and conclusion. Applicant asserts that substituting the “attachment means of Diener”, i.e. the inventive mechanical storage clip, with the “magnetic sleeve 30” of Kalisz, would not cause the tube to be made of a magnetic material. As discussed above, the sleeve 30 of Kalisz is made of magnetic material and the sleeve 30 holds the tube 40 which is made of plastic/polypropylene. Therefore substituting the “attachment means of Diener with the magnetic attachment means as taught by Kalisz” would yield a magnetic storage clip which would hold the non-magnetic tube. The magnetic sleeve 30 of Kalisz would hold the non-magnetic tube, if the magnetic sleeve 30 of Kalisz is literally substituted for the mechanical storage clip of Diener. Either way, it is the mechanical clip or sleeve 30 holding the tube that is magnetic, not the tube as recited in the instant independent claims.

Because neither Deiner nor Kalisz, individually or in combination, teach or suggest all the claim limitations of instant independent claims 18, 28 and 29, Applicant requests withdrawal of the rejection. It is recognized that dependent claims are non-obvious under section

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103 if the independent claims from which they depend are non-obvious. *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed. Cir. 1987); *In re Abele*, 684 F.2d 902, 910, 241 USPQ 682, 689 (CCPA 1982); see also *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, claims 18-33 are in condition for allowance and withdrawal of the rejection is respectfully requested.

### **Double Patenting**

In the Office Action, claims 18-33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of MacMurdo (US 6,659,313). Applicant has enclosed herein a Terminal Disclaimer as directed to U.S. Patent 6,659,313. Applicant believes that the enclosed Terminal Disclaimer is in compliance with 37 CFR § 1.321(c) and 37 CFR § 1.130(b).

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**Conclusion**


In light of the above comments, claims 18-33 are in condition for allowance.

Notification to that effect is respectfully requested.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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By:   
Edwin E. Voigt II  
Registration No.: 36042

6109 Blue Circle Drive, Suite 2000  
Minnetonka, MN 55343-9185  
Telephone: (952) 563-3000  
Facsimile: (952) 563-3001

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